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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/507,406	04/08/2005	Georg Frohlich	P04,0353	6881

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EXAMINER

MAI, THIEN T

ART UNIT	PAPER NUMBER
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2876

DATE MAILED: 12/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

2/2

Office Action Summary	Application No. 10/507,406	Applicant(s) FROHLICH ET AL.	
	Examiner Thien T. Mai	Art Unit 2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Acknowledgements

- Applicant's amendment filed on 12 November 2005 is hereby acknowledged. Claims 18-41 are under prosecution and are presented herein.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claim(s) 18-19, 22-27, 31-37, 39-40 is/are rejected under 35 U.S.C. 102(e) as being anticipated by Hohberger (20030063139)

Regarding claim 18, 31, 34-37, 39-40, Hohberger discloses a method for production of a printed document in a form of a ticket, label, or tag with a unique identifier such as RFID, comprising the steps of:

- applying a RFID transponder as data medium 52 for said unique identifier on a recording medium such as label 14 during a document/label production event; so that data is written to the data medium 52 without contact at a distance (Specification par. 0009) through antenna emissions (Specification par. 52)
- a computer program for writing data onto the data medium as being done in block 160 (see Figure 7)

wherein the data in the RFID transponder is “encoded with relevant card member information from database 314” (Specification par. 0111), implying that the data programmed in the

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RFID and data of the card user/member are from the database 314, which by definition is a collection of data stored in a file.

Regarding claim(s) 19, Hohberger discloses the RFID is being verified and printed "void" if verification fails (Figure 7, 15).

Regarding claim(s) 22-23, Hohberger discloses card number with customer name 250 (Figure 18) printed on a Platinum card or post card (Specification par. 106, 111) as the identifier printed in plain text is also contained in the transponder.

Regarding claim(s) 24, Hohberger discloses a card member data base as a file are linked to the person carrying the card having id written on the card and in the transponder (Specification par. 0111).

Regarding claim(s) 25, see discussion regarding claim 19.

Regarding claim(s) 26, Hohberger discloses the data stored in the transponder being encoded (Specification par. 0009, 11, 35).

Regarding claim(s) 27, Hohberger discloses if the transponder is found defective or verification of the transponder fails, the document is separated out and the process continues as normal (Specification par. 61).

Regarding claim(s) 32-33, Hohberger discloses a printer and computer program being included in the system (claim 152).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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4. Claim(s) 20, 38, 41 is/are rejected under 35 U.S.C. 103(a) as being unpatentable over Hohberger (20030063139) in view of Pagnol (6483426).

Regarding claim 20, 38, 41, Hohberger discloses all limitations set forth in this claim as discussed above except the data medium comprises an unchangeable identifier number in an electronic region. Pagnol (6483426) discloses such concept is known when a plurality of transponders are involved in an identify operation of multiple transponders. (Col. 1 lines 36-40, Col. 4 lines 50-53.) Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to implement the method of Pagnol for further improvement the security of the document that requires additional identification of the transponder.

5. Claim(s) 21, 28 is/are rejected under 35 U.S.C. 103(a) as being unpatentable over Hohberger (20030063139) in view of Fredlund (20020181009) and Barrette (US 6,593,853)

Regarding claim(s) 21, Hohberger discloses all limitations set forth in this claim as discussed above except for the transponder is applied to the document before being programmed. Fredlund discloses an electrophotographic printer embedded in a kiosk that makes postcards. The kiosk generates an identifier ID in step 102/202, which is stored in a barcode or rfid or magnetic strip, for the postcard, then receives user image and address information, sends information to the consumer and recipient, and then the post card is printed (figures 4-7, Specification par. 0047). Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to incorporate Fredlund's invention with the motivation for the desire to avoid wasting RFID tags with erroneous pre-programming.

Regarding claim(s) 28, Hohberger discloses all limitations set forth in this claim as discussed above except for the transponder is programmed after document has left printer. Barrette discloses an external programming module 18 placed adjacent to the printer to encode the RFID label as it is ejected from the printer (Abstract, figs 1-2). Therefore, it would have been obvious to one of ordinary skill in the

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art at the time of invention to incorporate Barrette's teachings with the motivation for the desire to avoid programming the label on an erroneous or defective printed document.

6. Claim(s) 29-30 is/are rejected under 35 U.S.C. 103(a) as being unpatentable over Hohberger (20030063139) in view of Kohut (US 6,343,241) and Grunes (US 6,816,075)

Regarding claim 29, Hohberger discloses all limitations set forth in this claim as discussed above except the information is stored in the data medium at the monitoring/detection point where the document is detected. Kohut discloses gas station as the monitoring station detects the customer ID code from RFID attached to a car and writes the transaction history to it each time the car comes to gas station for re-fueling (col. 8 lines 39-60). Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to incorporate Kohut's teaching by having a monitoring station such as of Kohut with the motivation for the desire for quality assurance checking by verification of the document for proper contents both printed on the document and written to the RFID.

Regarding claim(s) 30, Grunes discloses the information read from the RFID tag can be updated to the tag, a database, or both (col. 8 lines 50-65). Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to incorporate Grunes' teaching with the motivation for updating the database with other information found on the document, i.e. misprint and tampering.

Response to Amendment

Applicant's arguments, filed 12 November 2005, with respect to the rejection(s) of claim(s) 18-35 under 35 USC 102 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of new prior art.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thien T. Mai whose telephone number is 571-272-8283. The examiner can normally be reached on Monday through Friday, 8:00 - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Lee can be reached on 571-272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Thien T Mai
Examiner
Art Unit 2876

TM



**THIEN M. LE
PRIMARY EXAMINER**